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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,677	10/24/2006	Ingo Uckelmann	3059A/106	2911
2101 7590 04/27/2010 Sunstein Kann Murphy & Timbers LLP 125 SUMMER STREET BOSTON, MA 02110-1618				
EXAMINER				
JENNISON, BRIAN W				
ART UNIT		PAPER NUMBER		
3742				
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04/27/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,677

Applicant(s)

UCKELMANN ET AL.

Examiner

BRIAN JENNISON

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date 3/31/2008

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it is more than 150 words and is more than one paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-14 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose any specific algorithm for the "compensation

function" or how to combine the "compensation data" with the other data. Therefore, it requires undue experimentation to determine an operable algorithm.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, both claims 1 and 14 recite the broad recitation a beam source, and the claim also recites in particular a laser or an electron beam which is the narrower statement of the range/limitation.

8. Regarding claim 13, the word "means" is preceded by the word(s) "combining the compensation data..." (the means plus function is indefinite since no algorithm is disclose) in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Also see Aristocrats Techs. Austl Pty, Ltd. Vs. International Gaem Tech., 531 F.3d 1328 (Fed. Cir. 2008); and Ex Parte Rodriguez, 92 USPQ2s 1395 (BPAI 2009).

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a process. However, there is no transformation of a particular article. The claims merely involve the manipulation of data which does not require the use of a machine.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-5 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lui et al (US 2002/0145213).

Lui discloses regarding claim 1 a method of producing control data sets for the production of metallic and/or non-metallic products (see paragraph [0064]), by freeform sintering and/or freeform melting by means of a high-energy beam, in particular a laser beam or an electron beam (see paragraph [0087]), wherein a product is built up layer by layer out of a material to be added layer-wise by means of said beam guided by means of a control data set (see paragraph [0087]), wherein the method includes the steps of reading in a product target geometry data set which represents the target geometry of the product to be produced (see paragraph [0105]) and producing the control data set on the basis of the product target geometry data set, and the further steps of determining a compensation data set and/or a compensation function to compensate for manufacturing-related influences caused by sintering and/or melting, and combining the compensation data set with and/or applying the compensation function to the product target geometry data set to produce the control data set (see paragraph [0112] and Figure 6). Regarding claims 12-13 and 14; a device for producing control data sets for the production of metallic and/or non-metallic products, by freeform sintering and/or freeform melting by means of a high-energy beam, in particular a laser beam or an electron beam (see paragraph [0087]) wherein a product can be built up layer by layer out of a material which can be added layer-wise by means of said

beam which can be guided by means of a control data set, wherein the device comprises: means for reading in a product target geometry data set which represents the target geometry of the product to be produced, and means for producing the control data set on the basis of the product target geometry data set, means for determining a compensation data set and/or a compensation function to compensate for manufacturing-related influences caused by sintering and/or melting, and means for combining the compensation data set with and/or applying the compensation function to the product target geometry data set to produce the control data set (see paragraph [0012] and Figure 6). Regarding claims 2-5 and 9-10; the size, shape and angle of inclination of the product are all included in the data set from the 3D data set of mathematical surfaces. Since the object is mapped in 3D higher degree polynomials will be used. (See Fig 6. and paragraph [0112]) Regarding claims 11; the 3D geometry of the product is included in the data set.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lui et al (US 2002/0145213) in view of Riley et al (US 2002/0107604) .

The teachings of Lui have been discussed above. Lui discloses a function used to compensate for the design but fails to disclose the compensation function containing a higher order polynomial for complex geometry regions. Riley discloses using a polynomial of degree N in a data set function for use with complex 3D geometry. (See Paragraph 0185) It would have been obvious to adapt Lui in view of Riley to provide a

higher order polynomial because Riley discloses a polynomial of degree N for describing a complex function of data.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chung et al (US 6,627,835) teaches 3D object fabrication techniques using sintering with a laser.

Deckard (US 5,017,753) teaches sintering parts by a laser.

Bullock et al (US 5,488,478) teaches mapping the shape of a surface with a laser to create a data set.

Shi (US 2002/0100750) teaches a rapid prototyping method.

Darrah et al (US 6,677,554) teaches laser sintering with set build parameters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN JENNISON whose telephone number is (571)270-5930. The examiner can normally be reached on M-Th 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN JENNISON/
Examiner, Art Unit 3742

/Geoffrey S Evans/
Primary Examiner, Art Unit 3742

4/14/2010